

REMARKS

Entry of the above-amendments and reconsideration and withdrawal of the rejections are respectfully requested.

The rejection of claims 16, 32, and 41 as being rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention is traversed.

Claims 16, 32, and 41 have now been canceled.

In order to avoid any confusion in amending the Formula IV on page 6 and in claim 39, the Formula IV has been rewritten and a replacement page has been submitted in the specification and a new claim 48 has been submitted to replace claim 39. These amendments should clear up any confusion in the correcting of this Formula.

The rejection of claims 1-47 is being rejected under 35 USC 102(e) as being anticipated by Chen et al ('747) is traversed. Hence, since a Terminal disclaimer was filed in response to an obviousness type double patenting rejection and the Examiner has accepted this Terminal Disclaimer, it is submitted that the Chen et al ('747) patent is no longer valid prior art against the instant application. Both patents are owned by the same assignee and both patents will now expire on the same date. Hence, the instant application has now rectified the problem associated with double patenting of not extending length of the original patent by making sure that both patents expire on the same date.

It is submitted that an obviousness-type double patenting rejection is analogous to a rejection for obviousness under section 103, except that the patent principally underlying the rejection is not considered prior art. *Quad Environmental Tech. Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991); *in re Longi*, 759 F.2d 887, 225 USPQ645 (Fed. Cir. 1985). An applicant's disclosure cannot, of course, be used as prior art against him or her, even in an

obviousness-type double patenting context. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). The disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims. General Foods Corp. v. Sludrengeellschaft Kohle mbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992). Hence, since the above-mentioned Terminal Disclaimer has obviated the obviousness type double patenting rejection based on this patent. Therefore, this rejection is no longer valid and thus this becomes a moot issue. Hence, this reference is no longer a valid reference against the present application.

The rejection of claims 1, 5-12, 18-20, 22-24, 26-28, 30, and 32-37 under 35 USC 102(e) as being anticipated by, or, in the alternative, under 35 USC 103(a) as being obvious over WO 02/083592 is traversed. This reference does not disclose the present invention. Moreover, this reference is in a non-analogous art to the instant invention. This reference is directed to a method of decreasing the viscosity of a mineral ore slurry while the instant invention is directed to a building material composition. The term "building material" is defined in the paragraph starting on line 30 of page 7 to line 25 of page 8. In essence, building materials are defined as members of the class of construction materials, such as concrete, tile cements and adhesives, projection plasters, stuccos based on cement and synthetic binders, ready mixed mortars, etc. The WO '592 publication is not directed to a composition at all but rather to a method of reducing the viscosity of viscous mineral ore slurry in order to make the transporting, pumping, and agitation of the mineral ore slurry more efficient. Hence, it is quite clear that the WO '592 reference is from a different field of endeavor than the instant invention (this is the primary criteria to consider for non-analogous arts). The other criteria for determining non-analogous fields is whether the prior art reference is still reasonably pertinent to the particular problems with which the inventor is involved. Since the facts above demonstrate that the WO '592 reference is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). See also Heidelberger Druckmaschinen AG v. Hantscho Comm. Prods., Inc., 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1994).

It is submitted that the Examiner is not giving any weight to the preamble by making such a rejection using non-analogous prior art. On the subject of the preamble, the Federal Circuit in *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.* (9 USPQ2d 1962, Fed. Cir. 1989) said that:

“No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. To say that a preamble is a limitation if it gives “meaning to the claim” may merely state the problem rather than lead one to the answer. The effective preamble language can be resolved only on review of the entity of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”

In the instant application, the specification makes it quite clear that the inventors were working on building material formulations. The WO '592 publication makes it quite clear that it is dealing with a method of transporting mineral ore slurries. To read the claims of this WO '592 publication in light of the specification indiscriminately to cover all types of formulations would be divorced from reality. The instant invention is restricted to mortar and concrete formulations as defined in the specification which are significantly different than what the WO '592 publication intends. Hence, the claimed preamble as well as the ingredients in the claim limitations of the instant invention defines a specific and definite use that is non-analogous to that of a method of transporting mineral ore slurries.

The rejection of claims 30-47 under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Tanaka et al ('206) or EP 0 448 717 is traversed. In claims 30 and 39, the definition of c, d, and e have been added to the claims which are not disclosed in the Tanaka et al or EP patent. Moreover, it is submitted that these references do not disclose the co- or ter-polymer as defined in the claims of the instant invention. Hence, neither of these references anticipate the instant invention. Moreover, armed with either of these references would not be in possession of applications' invention since the polymers are different.

For the reason set forth above, it is submitted that this application is now in condition for allowance and notification thereof is respectfully requested.

Respectfully submitted,



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